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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,016

10/31/2003

Thomas Frietsch

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01/13/2009

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

DAILEY, THOMAS J

ART UNIT

PAPER NUMBER

2452

NOTIFICATION DATE

DELIVERY MODE

01/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/698,016	Applicant(s) FRIETSCH, THOMAS	
	Examiner Thomas J. Dailey	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/2008 has been entered.
2. Claims 32-48 were added by the amendment filed on 9/16/2008.
3. Claims 1-32 were cancelled by the amendment filed on 9/16/2008.
4. Claims 32-48 are pending.

Response to Arguments

5. Applicant's arguments with respect to the prior art rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 40-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claims 40-47 are directed to, "A server arrangement including..." or "A computer network...comprising" and all the limitations (e.g. "a network portion and a discovery portion") may be interpreted and implemented as software alone when read in light of the specification. Therefore the claims are directed to functional descriptive material that is not embodied on a computer system which is non-statutory.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 32-33, 35-36, 38, 39, 40-41, 43-44, and 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnard et al (US Pub. No. 2003/0005100), hereafter "Barnard."

11. As to claim 32, Barnard discloses a method of discovering that a particular network node having an assigned address has been connected to a computer network including (a) plural nodes, one of which is the particular node, and (b) a

server arrangement including a network portion and a discovery portion

(Abstract), the method comprising:

responding to the establishment of the connection of the particular network node to the network by transmitting an initial request from the particular node to the network portion of the server arrangement via the network ([0074], lines 16-21, printing device on network ("particular node") sends DHCP discover request ("initial request") to internal DHCP server ("network portion of server arrangement"), the initial access request including the assigned address of the particular node ([0074], DHCP discover request ("initial request") includes MAC address ("assigned address"));

the network portion of the server arrangement responding to the initial access request by initiating a discovery request and deriving an indication of the assigned address of the particular node ([0074], lines 30-35);

the network portion supplying the discovery request and the assigned address of the particular node to the discovery portion only after the network portion has determined that the particular node is an authentic node of the network ([0074], lines 30-35, DHCP server supplies MAC address ("assigned address" and IP address to discovery module ("discovery portion") after printing device ("particular node") has IP address (i.e. now the printer can communicate with other devices on the network and therefore is authentic);

the discovery procedure for the particular node including polling network topography, the polled network topography including other nodes to which the

particular node is connected, and the configuration of the particular node ([0077], lines 12-27).

12. As to claim 35, Barnard discloses a method of discovering that a particular network node having an assigned address has been connected to a computer network including (a) plural nodes, one of which is the particular node, and (b) a server arrangement including a network portion and a discovery portion (Abstract), the method comprising:

 responding to the establishment of the connection of the particular network node to the network by transmitting an initial request from the particular node to the network portion of the server arrangement via the network ([0074], lines 16-21, printing device on network ("particular node") sends DHCP discover request ("initial request") to internal DHCP server ("network portion of server arrangement"), the initial access request including the assigned address of the particular node ([0074], DHCP discover request ("initial request") includes MAC address ("assigned address"));

 the network portion of the server arrangement responding to the initial access request by initiating a discovery request and deriving an indication of the assigned address of the particular node ([0074], lines 30-35);

 the network portion supplying the discovery request and the assigned address of the particular node to the discovery portion only after the network portion has determined that the particular node is an authentic node of the

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network ([0074], lines 30-35, DHCP server supplies MAC address ("assigned address" and IP address to discovery module ("discovery portion") after printing device ("particular node") has IP address (i.e. now the printer can communicate with other devices on the network and therefore is authentic);

the discovery portion responding to the discovery request applied to the discovery portion by the network portion by storing the assigned address of the particular node and initiating a discovery program that performs a discovery procedure for the particular node ([0077], lines 12-27);

the discovery procedure for the particular node including determining status information about the particular node ([0077], lines 12-27).

13. As to claims 38, 39, 40, 43, and 46, they are rejected by a similar rationale to that set forth in claims 32 and 35's rejections.

14. As to claim 33, Barnard discloses the discovery portion receives a sequence of discovery requests including assigned addresses of various nodes of the network which have requested access to the network, the discovery portion storing the assigned addresses of the received request from the various nodes ([0077], lines 12-27 and Fig. 7).

15. As to claims 36, 41, 44, and 47, they are rejected by a similar rationale to that set forth in claim 33's rejection.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 34, 37, 42, and 45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard as applied to claims 36, 41, 44, and 47, and in further view of what was well known in the art at the time of the invention.

18. As to claim 34, 37, 42, and 45, Barnard discloses the invention substantially with regard to the parent claims 36, 41, 44, and 47, and but do not explicitly disclose the sequence of assigned addresses is stored as a stack that the discovery portion processes in first-in-first-out order. Barnard's does not go into specifics as to how the addresses are stored, just that they are.

Although Barnard does not explicitly suggest the use of a first-in-first-out order (FIFO) stack, Official Notice is taken (MPEP 2144.01) that using a FIFO stack as a means to store data was a well-known practice at the time of the applicant's invention was made, which is deployed to more easily manage

memory operations. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a known standard to modify the teachings Barnard in order to achieve such benefits.

19. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard as applied to claim 32, and in further view of Sistanizadeh et al. (US Pat. 5,790,548), hereafter "Sistanizadeh."

20. As to claim 48, Barnard discloses the particular node includes a portable computer and a docking station ([0041]).

But, Barnard does not disclose the docking station responding to the portable computer being initially connected to the docking station by booting the portable computer and performing a logon dialog between the network portion of the server arrangement and the portable computer; the logon dialog being the initial request; the network portion of the server arrangement responding to the logon dialog from the portable computer by determining if the portable computer is an authentic node of the network; the server arrangement, when connected to the portable computer that is an authentic node, functioning as a domain controller for the portable computer.

However, Sistanizadeh discloses the docking station responding to the portable computer being initially connected to the docking station by booting the portable computer and performing a logon dialog between a network portion of a

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server arrangement and a portable computer (Sistanizadeh, Fig. 7 and column 12, lines 7-14, as part of IP address assignment PC includes logon information); the logon dialog being the initial request (column 12, lines 8-14); the network portion of the server arrangement responding to the logon dialog from the portable computer by determining if the portable computer is an authentic node of the network (column 12, lines 8-14, PC sends login information so as to be authenticated); the server arrangement, when connected to the portable computer that is an authentic node, functioning as a domain controller for the portable computer (column 12, lines 21-30, server arrangement includes DNS server).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barnard and Sistanizadeh in order to provide greater security to the discovery procedures of Barnard by the means provided for in Sistanizadeh (i.e. user and password information).

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./
Examiner, Art Unit 2452

/Kenny S Lin/

Primary Examiner, Art Unit 2452